

REMARKS

Please reconsider the application in view of the foregoing amendments and the following remarks.

Status of Claims

Claims 1-4 are pending in the present application and are herein amended. No new matter has been presented.

Claim Rejections - 35 U.S.C. §112

The Office Action has rejected claim 3 under 35 U.S.C. 112, first paragraph because claim 3 recites “computer readable medium”. The Office Action contends that the specification does not disclose any computer readable medium or defines what is considered to be a computer readable medium. However, the Office Action acknowledges that, in paragraph [0056], the specification discloses “computer readable memory stores”.

Applicants respectfully traverse the rejection and submit that satisfaction of the written description requirement does NOT require in *haec verba* antecedence in the originally filed specification. In other words, the written description requirement does not require literal support for the newly added claim limitation. Rather, it is sufficient if the persons of ordinary skill in the art will recognize from the disclosure that applicant had possession of the concept including the newly added limitations. See MPEP 2163 and see also *In re Wertheim*, 541 F.2d 257, 191;

Stahelin v. Secher, 24 USPQ 2d 1513 (B.P.A.I. 1992); *Ex Parte Parks*, 30 U.S.P.Q 2d 1513 (BPAI 1994).

Applicants submit that a “computer readable memory storage” or “data storage device” such as CD-ROM/RW, hard drive etc. are computer readable medium and will be so recognized by persons of ordinary skill in the art.

In view of the foregoing, Applicants respectfully submit that the rejection under 35 U.S.C. §112, first paragraph is improper and respectfully request that it be withdrawn.

The Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph as being indefinite because claims 1, 3 and 4 are missing an antecedent basis. Applicants herein amend claims 1, 3 and 4 in order to overcome this rejection.

Claim Rejections - 35 U.S.C. §101

The Examiner has rejected claims 1 and 2 under 35 U.S.C. 101 stating that the claimed invention is directed to non-statutory subject matter and that the method claims are not tied to a particular apparatus.

Under *In re Bilski*, the CAFC has ruled that a claimed process is patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing.

Applicants herein amend claims 1 and 2 such that it is explicitly tied to a DNA micro-array preparing apparatus to overcome this rejection.

As to the Merits

As to the merits of this case, the Examiner sets forth the following rejections:

Claims 1 and 3-4 were rejected under 35 U.S.C. 102(b) as being unpatentable over **Kosuke et al.** (Patent abstracts of Japan 63-299400, IDS).

Claim 2 was rejected under 35 U.S.C. 103(a) as being unpatentable over **Kosuke et al.** (Patent abstracts of Japan 63-299400, IDS) and **Webb et al.** (UK 0010489.3, IDS).

Each of these rejections is respectfully traversed.

Claim Rejections - 35 U.S.C. §102

Independent Claims 1, 3 and 4

In order for a reference to anticipate an invention, the reference must teach each and every step/element of the claimed invention.

Claim 1 is drawn to at least ... *operating, on the basis of the position data of the fiducial mark 1 and the fiducial mark 2 rotated by 180 degrees, an amount of position shift from a rotational center of the holding member to a center of the object to be held and an amount of angle shift of the object in the horizontal plane with respect to a fiducial line of the holding member.* Claim 3 and 4 also recite similar subject matter.

For example, as noted on page 14, lines 7-12 of the present specification, “on the basis of the position data of the fiducial mark 1 (FM1) and the above-mentioned fiducial mark 2 (FM2’’) which is rotated by 180 degrees, the position shift amount from the rotational center O’ of the holding member 18 to the center of the head 7 and the angle (angular) shift amount of the object to be held, in the horizontal plane, with respect to the fiducial line of the holding member are operated (step S5).” *See also page 14, lines 13 to page 15, line 15 of the present specification.*

On page 6 of the Office Action, it is alleged that the Abstract of Kosuke disclose the above-stated features of claim 1.

It is respectfully submitted that the Examiner is mischaracterizing the teachings of Kosuke. More specifically, the Abstract of Kosuke explicitly teaches: **“A is one point in the image of a lead 3a, and its coordinates, (X1, Y1) are recognized [one time image processing]. Subsequently, the coordinates (X2, Y2) of point A', symmetrical with A, in the image of a lead 3b after rotation of the nozzle by 180° are recognized [two times image processing] ... Then, as to the error of the rotation center and the suction error of the IC, it is only needed that by the intaking of the image of a lead 3c [three times image processing] by the movement of the head section from the intaking of the image of the lead 3b, the gradient of the deviational amount of a point B of another lead from the point A' is corrected to zero, which another lead should originally be in the same direction as that moving direction.”**

In other words, as illustrated in drawing figure 4 and as noted above, in Kosuke, the positional shift and the angular correction is based on three times of image processing. That is, image of lead 3a (X1, Y1), image of 3b after 180 degree rotation (X2, Y2) and image of a lead 3c (X3, Y3) which is taken by moving the head section from the intaking of the image of the lead 3b as shown in drawing 3.

In contrast, in the claimed invention, the positional shift amount and the angular shift amount of the center of the holding member can be obtained by two times of image processing, for example, on the basis of the position data of the fiducial mark 1 and the fiducial mark 2 which is rotated by 180 degrees, the position shift amount from the rotational center O' of the

holding member to the center of the head and the angle (angular) shift amount of the object to be held, in the horizontal plane, with respect to the fiducial line of the holding member.

As noted above, in order for a reference to anticipate an invention, the reference must teach each and every element of the claimed invention.

Since Kosuke does not teach or disclose at least *operating, on the basis of the position data of the fiducial mark 1 and the fiducial mark 2 rotated by 180 degrees, an amount of position shift from a rotational center of the holding member to a center of the object to be held and an amount of angle shift of the object in the horizontal plane with respect to a fiducial line of the holding member* as recited in claims 1, 3 and 4, Applicants submit that the rejection is improper and respectfully request that it be withdrawn.

Claim Rejections - 35 U.S.C. §103

Dependent claim 2 is also patentable by virtue of its dependency on independent claim 1 since it incorporates by reference the distinguishing features of independent claim 1.

Conclusion

The Claims have been shown to be allowable over the prior art. Applicants believe that this paper is responsive to each and every ground of rejection cited in the Office Action dated

Application No. 10/525,751
Art Unit: 2624

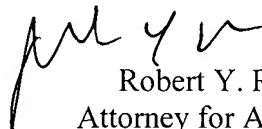
Amendment under 37 C.F.R. §1.111
Attorney Docket No. 052193

June 2, 2009, and respectfully request favorable action in this application. The Examiner is invited to telephone the undersigned, applicants' attorney of record, to facilitate advancement of the present application.

If this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. The fees for such an extension or any other fees that may be due with respect to this paper may be charged to Deposit Account No. 50-2866.

Respectfully submitted,

WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP

A handwritten signature in black ink, appearing to read 'R. Y. Raheja', is positioned above the printed name and title.

Robert Y. Raheja
Attorney for Applicants
Registration No. 59,274
Telephone: (202) 822-1100
Facsimile: (202) 822-1111

R.YR/bam